

## **REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

New claims 9-11 are added. Claim 12 is supported by paragraph [0030] of the published application, US 2008/0058506. Claim 10 is a combination of claims 1, 3 and 9. Claim 11 is claim 7 made dependent on new claim 10.

Applicants do not believe the new claims introduce new matter. An early notice to that effect is earnestly solicited.

The specification was objected to because it was not submitted on a separate sheet. In response, the abstract is now resubmitted on a separate sheet.

The specification was objected to as lacking a brief description of the drawings. In response, a brief description of the drawings is added by the amendments above.

The specification was objected to as lacking “the required format” for presentation as provided by 37 CFR 1.77(b). In response, Applicants point to the first full paragraph on page 7 of the Office Action, indicating that the guidelines are only a “preferred layout,” and “suggested.” Applicants would prefer not to use such arrangement, but, may reconsider if the Examiner insists.

Claim 4 was objected to because of an informality. In response, Applicants have amended claim 4 in the manner suggested by the Examiner.

Claims 2 and 3 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Applicants have

amended the claims as suggested by the Examiner.

Claim 7 was rejected under 35 USC § 112, second paragraph, as being indefinite.

According to the Examiner, claim 7 is improperly dependent on claim 1 because claim 7 states that the micromixer is optional whereas claim 1 requires a micromixer. In response, Applicants point out that claim 1 requires feeding to a micromixer, mixing intensively in the micromixer and then optionally feeding from the micromixer into a delay structure. Claim 1 is silent about the structure of the delay structure. Claim 7 provides details on the delay structure, providing that the reaction mixture is pumped in circulation in the delay structure, and further that a micromixer is optionally inserted into the circuit. Thus, claim 7 is properly dependent on claim 1. Claim 1 mentions feeding to the micromixer and then optionally feeding to a delay structure. Claim 7 incorporates these same requirements, and then further provides that the delay structure itself optionally contains a micromixer. The micromixer in the delay structure would be in addition to the micromixer mentioned in claim 1. In other words, claim 7 contemplates the possibility of using *two* micromixers—one *outside* the delay structure (the micromixer mentioned in claim 1) and one *inside* the delay structure (the optional micromixer mentioned in claim 7). Respectfully, claim 7 is clear and is properly dependent on claim 1. An early notice to that effect is earnestly solicited.

Claims 1-6 were rejected under 35 USC § 102(b) as being anticipated or, in the alternative, under 35 USC § 103(a) as being obvious over Spikmans, *Rapid. Commun. Mass Spectrometry*, 16: 1377-1388 (2002). In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

At the bottom of page 12 of the response, the Examiner writes “[t]he instant claim 1 is drawn to a process for labeling biomolecules, an intended use.” However, Applicants point out that a preamble has the import that the claim, as a whole, suggests it has. Here, the body of the claim makes references back to the preamble and, thus, it is clear that Applicants have used the preamble to define their invention and, moreover, the body of the claim makes no sense without reference to preamble. Thus, the body of claim 1 makes reference to “both compounds,” and this is clearly a reference to the “biomolecules” and “label compound” recited in the preamble. The preamble, thus, is necessary to breath life and meaning into the claim, and the Examiner cannot simply ignore it. Consequently, the Examiner must give the preamble weight, and not ignore it as a statement of intended use, and, therefore, Spikmans does not anticipate the instant claims.

Further, the Examiner has not pointed to any biomolecules that are labeled using Spikman’s process. At the bottom of page 11, the Examiner takes the position that Spikmans discloses a method of labeling amines, ketones and aldehydes. However, the Examiner has not made a case that these are biomolecules, or that these biomolecules are labeled according to Spikmans’ process. Accordingly, again, there is no anticipation.

Regarding the question of alleged obviousness, the Examiner might find it of interest to know that the corresponding European application has been granted. Applicants respectfully submit that this application also represents a patentable advance over Spikmans in that Spikmans’ process has clearly described limitations that would make it unsuitable for use in labeling biomolecules on a large scale and, therefore, persons skilled in the art would not have been motivated to adapt Spikman’s process for that purpose.

In particular, Spikmans discloses merely an analytical procedure for the processing of only minimal amounts of substance. Furthermore, the maximum obtainable yield is below 50% (p. 1383, left column, top). Thus, the Spikmans procedure is not suitable for the preparation of large amounts of product.

On the other hand, the presently claimed invention is a preparative procedure that permits the production of bigger amounts of product, and that exhibits a surprising improvement in both yield and selectivity in the reaction of marker with e.g. protein. In this regard, Applicants call the attention of the Examiner to paragraphs [0063] and [0070] of the published application, showing the inventive process of labeling biomolecules leads to improved sample quality and even improved activity. These advantages of the inventive process are neither disclosed nor suggested by Spikmans, and constitute objective evidence of nonobviousness. Although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance.

However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,  
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